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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,159	07/20/2001	Mara Q. Devitt	05222.00131	2587

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EXAMINER	
FISCHETTI, JOSEPH A	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/910,159	DEVITT ET AL.	
	Examiner	Art Unit	
	Joseph A. Fischetti	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) *12-35,37 and 38* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

The following is the classification for claim 35 which had not been previously identified.

Claim 35, drawn to a memory medium, classified in class 369, subclass 272.2.

The memory medium has separate utility as a disc for playing music.

Claims 12-35, 37,38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,5,6,9 10,and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose.

Rose discloses a method of identifying clothing combinations, the method comprises:

(a) identifying a first article of clothing and a search request (col. 8 lines 48-51 discloses the user selecting START AGAIN which is read as a search request and then selecting an article of clothing form one of a plurality of such articles;

(b) identifying a set of rules for selecting clothing combinations (col. 8 lines 52 et seq. selection of the fashion reflection submenu is read as identifying since it must be identified before it is selected) ;

(c) transmitting the identification of the first article of clothing, the search request and the identification of the set of rules to a rules engine (Fig. 5 illustrates the result of such a transmission which occurs once the user inputs); and

(d) receiving an identification of a second article of clothing that satisfies the set of rules (see cols 9 and 10 under Do's to wear).

Re claim 2: wherein the set of rules includes rules for permissible color combinations see col. 9 line 63, col. 10 line s36, 23-26 .

Re claim 3: wherein the set of rules include rules for permissible pattern combinations see col. 9 line 30, col. 10 lines 5,14.

Re claim 10: identifying an owner of the first article of clothing is met by the fact that the user inherently owns one piece.

Re claim 5: selecting the first article of clothing from a selection of clothing in a brick and mortar store (col. 1 lies 10-50 discuss resolving problem of trying on in department stores).

RE claims 6, 9: selecting the first article of clothing from a selection of clothing offered for sale by a web site (col. 1 lies 10-50 discuss resolving problem of trying on in internet stores).

RE claim 11: receiving the identification of a third article of clothing that satisfies the search request is read as the third of the plural suggestions set forth under the categories DO WEAR in cols 9 and 10.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, (36 newly added) are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al.

Suzuki et al. disclose:

a) identifying a first article of clothing and a search request (clothing article is taken into fitting room and search engine 40 starts request);

(b) identifying a set of rules for selecting clothing combinations (col. 6 lines 50 et seq. engine 40);

(c) transmitting the identification of the first article of clothing, the search request and the identification of the set of rules to a rules engine (RF tag transmits the item taken into fitting room and identifies rules based upon PLU table); and

(d) receiving an identification of a second article of clothing that satisfies the set of

rules (see col. 7 recommendation list 54 includes products with a similar style). RER claim 36: the trial history 70 is read as an editing the set of rules as the trial history is updated by different clothing and hence the rules are changed by new habits.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose. Whether the article is owned by the user or not does not constitute a patentability because ownership of an article is not a patentable feature. Also, official notice is taken to the notorious well known practice of comparing an owned piece of garment to one in a store, or between the garment one holds in one's closet.

Claims 1, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Markman. Rose discloses the invention substantially as claimed except that there is no disclosure of using an RF tag to identify an article of clothing. However, Markman discloses such a tag 14. It would be obvious to modify Rose with the step of reading a tag embedded in the first article of clothing because the motivation would be to enhance through put of data.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant argues that that Rose does not teach a set of rules for selecting clothing combinations. Instead, applicant portrays Rose as merely describes a "fashion shapes" based upon body type.

However, it is the examiner's position is that the disclosure in Rose ultimately results in a combination of clothing articles which resulted from a rules generated engine. Specifically, the rules engine in the instance of offering a first article of clothing suggests in col. 8 lines 65-66 "boleros, cropped jackets and short, taylored jackets with small labels and collars.." There can be no argument that these items are clearly articles of clothing and answer the limitation of "first article". Next the system presents a "Do wear" list, which, albeit, is generated by using a body type category, nevertheless transmits DO WEAR items. These items are specifically identified as "pleated and dirndl skirts...", "peplums" ...and "blouses"". These again are articles of clothing which answer the limitation of "a second article of clothing" and are presented as a combination.

Applicant arguments regarding the 103 rejection are based upon the alleged shortcoming of Rose. However, since the above analysis makes it clear that Rose does read on the very broadly worded claims, the 103 rejection remains valid.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to PRIMARY EXAMINER Joseph A. Fischetti at telephone number (703) 305-0731.

JF